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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/769,761 | 01/26/2001 | Mark T. Wajer | 46396-628 | 7396 |

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EXAMINER

ALVO, MARC S

ART UNIT PAPER NUMBER

1731

DATE MAILED: 12/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/769,761

Applicant(s)

WAJER ET AL.

Examiner

Steve Alvo

Art Unit

1731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14, 16-30, 32-45 and 47-57 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14, 16-30, 32-45 and 47-57 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1731

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-14, 16-30, 32-45 and 47-57 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over LINDAHL (4,029,543).

LINDAHL teaches bleaching mechanical pulp with peroxide and a magnesium salt, e.g. magnesium hydroxide (column 3, line 8) wherein the bleaching liquor only contains peroxide as bleaching chemical (column 3, lines 46-57) and wherein the bleach liquor can be spent peroxide liquor (column 3, lines 23-25). The instant claims do not exclude the chelating agent of LINDAHL as the instant bleach liquor can include a chelating agent, see instant claims 2 and 33). See column 2, lines 29-68 for chelating agents. See column 4, lines 12-14 for temperature of 45 to 65 °C for 2 to 5 hours. See, column 2, lines 14, for a pH of 8.5. See column 3, lines 16-15 for adding the chelating agent prior to the bleaching stage. If necessary it would have been obvious that only magnesium hydroxide and peroxide could form the bleaching agent as LINDAHL teaches that the chelating agent can be added at an earlier stage.

Claims 1-14, 16-30, 32-45 and 47-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 96/41917 as applied to claim 1 above, and further in view of LINDAHL.

Art Unit: 1731

WO 96/41917 teaches bleaching mechanical pulp (see Field of the Invention) with 1-5% peroxide in the absence of silicate and sodium hydroxide using 0.3 to 2% MgO, based on the weight of the pulp, having large particle surface areas to obtain a high ISO brightness at high bleaching efficiency. The MgO of WO 96/41917 is added prior to or simultaneously with the peroxide. WO 96/41917 further teaches that the pulp can be pretreated with a chelating agent to remove detrimental metal ions from the pulp, see page 3, 6th full paragraph. LINDAHL teaches the alternativeness of adding MgO or Mg hydroxide to peroxide bleach liquor. It would have been obvious to use the alternative magnesium hydroxide of LINDAHL for the MgO of WO 96/41917. It would have been obvious to use the bleach conditions of LINDAHL for the peroxide bleach conditions. See column LINDAHL, 4, lines 12-14 for temperature of 45 to 65 °C for 2 to 5 hours; column 2, lines 14 for a pH of 8.5; column 3, lines 16-15 for adding the chelating agent prior to the bleaching stage.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-14, 16-30, 32-45 and 47-57 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. It is not seen where the terms "consisting essentially of water and hydrogen peroxide" and "consisting essentially

Art Unit: 1731

of water and magnesium hydroxide” were originally disclosed. These terms do not exclude non-essential material, e.g. sodium hydroxide or other non-essential additives.

The arguments that WO ‘917 discloses a maximum brightness of 65 is not convincing as claim 1 is only limited to a brightness of “up to 75”. This does not define over the “65” of WO ‘917.

The argument that LINDAHL uses the magnesium hydroxide as a stabilizer instead of an alkaline source is not convincing as hydroxides are well known to be alkaline and it would have been obvious to the routineer that it would function as both a stabilizer and an alkaline source.

Claims 1-14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, line 9, the term “and a the aqueous bleaching mixture” should be changed to “and the aqueous bleaching mixture”. Claim 2 is indefinite as it is not clear when the chelating agent is added. If it is added with the peroxide or magnesium hydroxide, the claim is improper as such addition excludes by the phrases “consisting essentially of” in claim 1. How does the scope of this claim differ from the scope of claim 16?

If Applicant can show basis for “consisting of water and hydrogen peroxide” and “consisting of water and magnesium hydroxide”; then claim 1 would be allowable if amended to “consisting of water and hydrogen peroxide” and “consisting of water and magnesium hydroxide” and combined with claims 13 and 14

Art Unit: 1731

The Canadian Patent was dropped as a reference in the last Office Action as Applicant has pointed out that a 131 Declaration was filed to overcome the reference.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

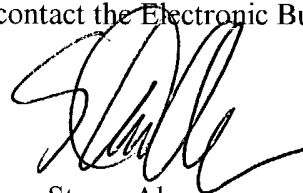
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steve Alvo whose telephone number is 571-272-1185.

The examiner can normally be reached on 5:45 AM - 2:15 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1731

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Steve Alvo
Primary Examiner
Art Unit 1731

msa